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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/734,461	12/12/2003	Bonnie M. Pemberton	31960.0104	9697
7590 Schlutz & Associates, P.C. 5400 LBJ Freeway Dallas, TX 75240				
EXAMINER				
OSILE, MARK A				
ART UNIT		PAPER NUMBER		
1791				
MAIL DATE		DELIVERY MODE		
09/23/2009		PAPER		

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte BONNIE M. PEMBERTON
and FRANK A. WOLFE

Appeal 2009-006175
Application 10/734,461
Technology Center 1700

Heard: 17 September 2009
Decided: 23 September 2009

Before CHUNK K. PAK, PETER F. KRATZ, and MARK NAGUMO,
Administrative Patent Judges.

NAGUMO, *Administrative Patent Judge.*

DECISION ON APPEAL

A. Introduction^{1, 2}

Bonnie M. Pemberton and Frank A. Wolfe (“Pemberton”) timely appeal under 35 U.S.C. § 134(a) from the final rejection³ of claims 1-3.⁴ We have jurisdiction under 35 U.S.C. § 6. We AFFIRM.

The subject matter on appeal relates to an article of manufacture comprising a set of double-sided adhesive strips adhered side-by-side to a transfer sheet on one face and to corresponding completely bisected release layers on the other. The adhesives are selected to be releasable from common home furnishings, and to be unpleasantly tacky to pets that touch the strips. For that reason, the double-sided adhesive strips are said to be useful for deterring pets from scratching furniture.

¹ Application 10/734,461, *Method and Device for Preventing Pets from Clawing Home Furnishings*, filed 12 December 2003, claiming the benefit under 35 U.S.C. § 120 of 08/810,049, filed 4 March 1997, now U.S. Patent 6,692,594, which claims the benefit under 35 U.S.C. § 119(e) of 60/012,825, filed 5 March 1996. The specification is referred to as the “461 Specification” and is cited as “Spec.” The real party in interest is listed as Bonnie Pemberton. (Appeal Brief, filed 17 July 2008 (“Br.”), 2.)

² The Official Transcript, which was not available when this Opinion was entered, will be made of record.

³ Office action mailed 27 December 2007 (“Final Rejection”; cited as “FR”).

⁴ The only other pending claims, claims 7-15, have been withdrawn from consideration. (FR 1.)

Representative Claim 1, annotated with labels from Figure 2
(reproduced *infra* at 6), reads:

1. A device for deterring pets from scratching fabric of home furnishings comprising:

a continuous, unperforated and generally planar transfer sheet [15];

a plurality of continuous unperforated rectangular strips [13], each of the strips having a length substantially greater than its width, the strips [13] being arranged side-by-side on the transfer sheet, each of the strips [13] having first [25] and second [23] adhesive surfaces on opposite sides, each of the strips [13] being releasably adhered to the transfer sheet [15] on the first adhesive surface [23];

a plurality of continuous unperforated release layers [27], each of the release layers being completely bisected along an axis [29] parallel to the length of the strip [13] and each of the release layers [27] having a length substantially the same as the length of each of the strips, each of the release layers [27] releasably adhered on the second adhesive surface [23] of the strips [13];

wherein the strips [13] are adapted to be removed from the transfer sheet [15] and releasably adhered to the home furnishing on the first adhesive surface [25], and the release layers [27] are adapted to be removed from the second adhesive surface [23] revealing the second adhesive surface [23]; and

wherein the first and second adhesive surfaces are formulated from an adhesive of sufficient tack strength to cause a releasable sticking sensation.

(Br., Claims App. 1; indentation and bracketed labels to Figure 2 added for illustration only.)

The Examiner has maintained the following ground of rejection:⁵

Claims 1-3 stand rejected under 35 U.S.C. § 103(a) in view of the combined teachings of Straub,⁶ Ferraro,⁷ and Kriozere,⁸ and optionally⁹ Ittershagen.¹⁰

Pemberton contends that the Examiner failed to articulate a prima facie case of obviousness by: failing to provide an articulate explanation of the alleged obviousness; failing to demonstrate sufficient suggestion or motivation to combine the references, which, according to Pemberton, among other things, teach away from one another; and by failing to show that “completely bisected” release layers are taught or suggested by the prior art. Moreover, Pemberton contends that secondary considerations of commercial success, recognition by way of industry awards, and copying by competitors, rebut any prima facie case of obviousness. Pemberton submits as supporting evidence the testimony of Ms. Bonnie Pemberton, an inventor, and the testimony of Mr. Chris Ruben, president and chief executive officer of CMR Creative Marketing Resources, Inc., the firm that markets products for Ms. Pemberton’s company.

⁵ Examiner’s Answer mailed 1 October 2008. (“Ans.”).

⁶ Dale K. Straub, *Transfer Adhesive Sheet Material*, U.S. Patent 4,824,702 (1989).

⁷ Charlotte L. Ferraro, *Artificial Nail Mounting, Reinforcement, and Method*, U.S. Patent 4,511,608 (1985).

⁸ Richard A. Kriozere, *Pressure Sensitive Seal*, U.S. Patent 4,348,440 (1982).

⁹ In the Final Rejection, the Examiner’s reliance on Ittershagen was not optional. (FR 2.)

¹⁰ Stephan J. Ittershagen and Daniel C. Ittershagen, *Tacky-Surface Animal Repeller*, U.S. Patent 5,168,831 (1992).

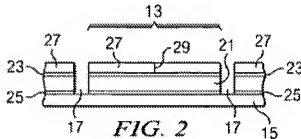
As evidence of obviousness, the Examiner relies, in part, on Ittershagen, which describes double-sided transparent adhesive films provided with a single release layer in rolls. The adhesive films are said to have appropriate tack strength for attaching to home furnishings and to deter cats from scratching. The Examiner relies on Straub and Ferraro for teachings of various other release layers in combination with double-sided pressure-sensitive adhesive strips, and on Kriozere for its teachings of completely split release layers covering an adhesive layer. The Examiner holds that the combination of different release layers with double-sided adhesive layers would have been an obvious substitution of various known components for their known purposes. The Examiner declines to credit the evidence of commercial success because, in the Examiner's view, the strength of the market argument could not be evaluated based on the evidence provided by Pemberton. (Ans. 7-8.)

B. Findings of Fact

Findings of fact throughout this Opinion are supported by a preponderance of the evidence of record.

The 461 Specification

1. An embodiment of the claimed invention is depicted in cross section in Figure 2 of the 461 Specification, which is reproduced *infra*:



{Figure 2 is said to show a cross section of a furniture protector}

2. The furniture protectors are described as comprising an array of multilaminate, rectangular strips 13 reversibly affixed to a transfer sheet 15 and separated from one another by gaps 17. (Spec. 5, Il. 2-4.)
3. The 461 Specification describes each strip 13 as having a plastic film or substrate 21, which has adhesive coatings 23 and 25 on either side of the film. (Spec. 5, Il. 4-6.)
4. The strips 13 and coatings 23, 25, are said to be preferably transparent, so as to be “substantially invisible” when affixed to furniture. (Spec. 5, Il. 6-7.)
5. According to the 461 Specification, “[i]n the embodiment shown, release layer 27 is longitudinally *bisected into two separate portions* as shown by cut 29.” (Spec. 5, Il. 13-14; emphasis added.)

6. The 461 Specification teaches that one or more strips 13 are peeled from transfer sheet 15 and removably affixed to an item of furniture via adhesive coating 25. (Spec. 5, ll. 15-20.)
7. Adhesive coating 25 is said to have sufficient strength to remain affixed to the furniture when the cat attempts to scratch the furniture. (Spec. 6, ll. 4-5.)
8. Release layer 27 is then “easily removed from strip 13 by peeling the two portions of release layer 27 along cut 29, thereby exposing coating 23.” (Spec. 5, 21-23; emphasis added.)
9. The exposed adhesive coating 23 is said to provide “an unpleasant sticking sensation” to the paws of an inquisitive cat or other pet, “detering the cat from future contact with that item of furniture.” (Spec. 6, ll. 1-4.)

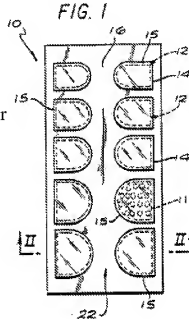
The Prior Art

10. Ittershagen describes a tacky-surfaced “animal repeller” comprising a sheet of transparent material coated on both sides with non-permanent adhesives. (Ittershagen, abstract; col. 2, ll. 11-14.)
11. According to Ittershagen, the coating on one side of the sheet is designed to “adhere to typical floor coverings, such as tile and carpet, and yet be easily removable at will.” (Ittershagen, col. 2, ll. 14-16.)
12. The coating on the other side is said to be “designed to stick to the paws of an animal stepping on it and require a forceful and unpleasant effort for the animal to free itself from its grip.” (Ittershagen, col. 2, ll. 16-20.)

13. The coated sheet material is provided as a roll, optionally with an intermediate layer of non-sticky backing material to “avoid bonding between the adhesive surfaces.” (Ittershagen, col. 3, ll. 42-50.)

14. Straub describes, with reference to Figure 1, reproduced right, transfer adhesive areas 12, which are said to be useful “for applying a predetermined shape of adhesive for the binding of two objects.” (Straub, col. 1, ll. 9-11.)

15. Figure 1 shows a sheet 10 including a bottom liner 16 and transfer adhesive areas 12 covered by tab top liners 14. (Straub, col. 2, ll. 47-52.)

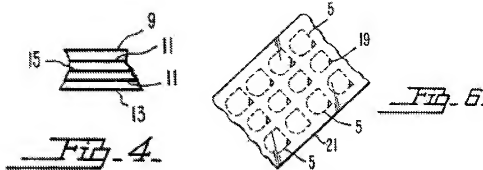


{Straub Figure 1 is said to show a sheet of transfer adhesive tabs}

16. Tab top liners 14 are said to be slightly larger than the transfer adhesive tab “such that adhesive will not be cut during the die cut operation.” (Straub, col. 2, ll. 53-58.)

17. Straub does not describe tab top liners 14 as being cut or “bisected.”

18. Ferraro describes adhesive tabs 5 shown in the cross section in Figure 4 and on a sheet 21 in Figure 6, which are reproduced below:



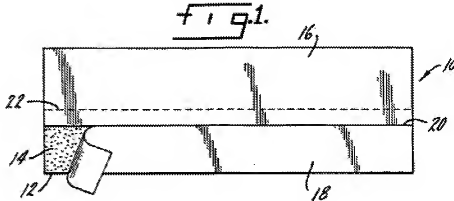
{ Fig. 4 shows an adhesive tab in cross section; Fig. 6 shows a sheet of tabs }

19. According to Ferraro, adhesive tabs 5 can be fabricated from a plastic sheet or film 15, “coated on each side by a pressure-sensitive adhesive 11, with protective coatings or coverings 9 and 13,” which may be, for example, waxed paper. (Ferraro, col. 2, ll. 47-54.)

20. Ferraro teaches that when the adhesive tabs 5 are provided on a sheet 21, as shown in Figure 6, “embossed lines 19 are provided on each side of the protective layers 9, 13, of the tabs 5 to facilitate removal of the protective layers.” (Ferraro, col. 3, ll. 3-10.)

21. Ferraro does not teach that protective layers 9 or 13 are cut through along embossed lines 19.

22. Kriozere describes a pressure-sensitive seal member 10, shown below,



{ Kriozere Figure 1 is said to show a pressure sensitive seal }

in which the pressure sensitive adhesive face 14 is covered by two liners or backing strips 16 and 18, which are described as being in “edge contact” with one another along longitudinal line 20. (Kriozere, col. 1, l. 65, to col. 2, l. 6.)

Pemberton Declaration 1¹¹

23. Ms. Pemberton testifies that her business, Fe-Lines, Inc., has been in business “since about 1981.” (Pemberton Decl. 1, ¶ 3.)

24. According to Ms. Pemberton, the “flat” version of the invention, attached as Exhibit A to her Declaration, “incorporates the elements of claim 1” of the 461 Application. (Pemberton Decl. 1-2, ¶ 4.)

25. Exhibit A is an image of packaging labeled “Sticky Paws” and a product apparently comprising three strips, similar in appearance to 461 Application Figure 1.

¹¹ Declaration of Bonnie Pemberton, originally filed 11 September 2006, cited as “Pemberton Decl.” (App. Br., Evidence Appendix, Exhibit 2.)

26. Ms. Pemberton testifies further that a corrugated version, corresponding to claim 42, is shown in Exhibit B. (Pemberton Decl. 1-2, ¶ 4.)
27. Claim 42 is not before us in this appeal.
28. Ms. Pemberton testifies that “Fe-Lines, Inc. began selling the claimed invention in 1996,” and that the sales in 1996 amounted to \$26,000, based on about 3,250 units. (Pemberton Decl. 2, ¶ 6.)
29. According to Ms. Pemberton, sales in 2005 were \$1 Million, based on “just over 203,000” units. (Pemberton Decl. 2, ¶ 6.)
30. Ms. Pemberton testifies further, “I estimate the size of the market for those particular products to be about \$1,500,000.00 per year. Our percentage of that market or market share I estimate to be approximately 70-80%.” (Pemberton Decl. 2, ¶ 7.)
31. Ms. Pemberton states, “[o]ver the years, our market share has grown. With the appearance of similar products, our market share has grown from 0% to almost 80% in less than 10 years.” (Pemberton Decl. 2, ¶ 8.)
32. Ms. Pemberton does not give separate figures for sales of the flat or the corrugated versions of the invention.
33. Ms. Pemberton does not further define the “market for those particular products.”
34. Ms. Pemberton does not explain the basis of her estimate of the size of the market for these products.
35. Ms. Pemberton does not explain the basis of her estimate of Fe-Lines, Inc.’s share of the market.

36. Ms. Pemberton testifies that “[t]he products sold by Fe-Lines, which incorporate the claimed invention have been the subject of industry recognition and awards.” (Pemberton Decl. 3, ¶ 13.)

37. Ms. Pemberton presents a Certificate of Achievement, 1998 Editors Choice Award, “for one of the Best New Cat Products of 1997/Sticky Paws for Plants & Sticky Paws for Furniture.” (Pemberton Decl., Exhibit H.)

38. Ms. Pemberton also presents a redacted letter to “FE-LINES, Inc.,” dated February 19, 1999, the body of which reads,

I ran an endorsement for Sticky Paws on page 8 of this winter edition of our newsletter. This is hardly big time - CATNIP! goes out to about 350 customer household - but at least it's a class publication with an attentive readership.

This was a completely spontaneous endorsement based on our experience with your product.

(Pemberton Decl., Exhibit I.)

39. Ms. Pemberton presents an ASPCA® Consumer Products New Release dated February 1, 2000, announcing, “ASPCA® Seal of Approval Granted to Sticky Paws for Furniture™ And Sticky Paws For Plants™.” (Pemberton Decl., Exhibit J.)

40. The ASPCA® New Release states, in most relevant part:
Sticky Paws™ for Furniture stops cats for [sic] scratching furniture. These 2” × 12” transparent acrylic adhesive strips apply directly to furniture, drapes, stereo speakers, counter-tops and anywhere else cats should not be! Sticky Paws™ is a safe and effective product that won’t harm cats or furniture. It is water-soluble and won’t leave a residue when removed.

(Pemberton Decl., Exhibit J.)

41. None of award Exhibits H, I, or J refer to the release strips or the structure that is recited in claim 1 of the 461 Application.
42. Ms. Pemberton testifies that “[t]he products incorporating the claimed invention have been recommended in award-winning books.” (Pemberton Decl. 4, ¶ 22, listing four books.)
43. The content of those recommendations has not been made of record in this appeal.
44. Ms. Pemberton presents, as evidence of copying, an image of a first competitor’s product in Exhibit D. (Pemberton Decl. 3, ¶ 18.)
45. The copy of Exhibit D in the Evidence Appendix shows a virtually featureless dark grey trapezoid against a black background.
46. The copy of Exhibit D in the official record of the application (the “eDAN” database) filed on 11 September 2006 shows a white trapezoid with a rectangular array of blotches against a black background.
47. Ms Pemberton presents a copy of the instructions said to be associated with the first competitor’s product in Exhibit E. (Pemberton Decl. 3, ¶ 19.)
48. Ms Pemberton presents Exhibit F, a redacted copy of what is said to be a web page showing a similar product from a “second competitor,” and Exhibit G, a redacted copy of what is said to be instructions associated with the second competitor’s product. (Pemberton Decl. 3, ¶¶ 20, 21.)
49. Ms. Pemberton characterizes the instructions for the first and second competitors products as being “almost identical” (Pemberton Decl. 3, ¶ 19) and “closely copied” (*id.* at ¶ 21) versions of the instructions accompanying the inventive product (Exhibit C), respectively.

50. Comparison of the pictures of the items and the text of the instructions shows similarities of shapes and wording.

51. Ms. Pemberton also submits in Exhibit K a redacted report of the composition of adhesives in the Fe-Lines, Inc., product and the first and second competitors' products. (Pemberton Decl. 3, ¶ 18.)

52. The redacted report in Exhibit K does not identify who conducted the tests; nor are any test data provided. (Evidence App., Exhibit K.)

53. Moreover, according to the report, the adhesives in the first and second competitors' products are different from the one used in Pemberton's product. (Evidence App., Exhibit K.)

54. Ms. Pemberton testifies that, "[a]lthough I am unaware of the exact date that this [first] competitor's product went into public use, I became aware of it well after I invented and began selling the devices as shown in Exhibits A & B and claimed in Patent Application Number 10/734,461." (Pemberton Decl. 3, ¶ 18.)

55. Ms. Pemberton does not further testify as to when the second competitor's product went into public use, or when she became aware of it.

Ruben Declaration¹²

56. Mr. Ruben testifies that he is "the president and chief executive officer of CMR Creative Marketing Resources, Inc.," which has been marketing products for Fe-Lines, Inc., for a period of 8 years. (Ruben Decl. 1, ¶ 2.)

¹² Declaration of Chris Ruben, originally filed 11 September 2006, cited as "Ruben Decl." (App. Br., Evidence Appendix, Exhibit 3.)

57. Mr. Ruben testifies that he has sold pet products for many years.
(Ruben Decl. 1, ¶ 3.)

58. Mr. Ruben testifies further that “[t]he product has been immensely successful in the marketplace. It has grown from a market share of approximately zero in 1996 to a zenith to control a market share of approximately 80% of this product in the United States.” (Ruben Decl. 1, ¶ 4.)

59. Mr. Ruben does not further define the market or what goods are equivalent to “the product.”

60. Mr. Ruben does not explain the basis of his conclusion that “the product” controls about 80% of the market.

61. Mr. Ruben does not explain what proportion of the market any particular product sold by Fe-Lines, Inc., “controls.”

62. Mr. Ruben testifies that he has attended domestic and international trade shows at which the “product of Fe-Lines incorporating the elements of the invention” has been displayed, and that at these shows, he has also seen competing products that at least one of Fe-Line’s customers has bought.
(Ruben Decl. 1-2, ¶ 5.)

63. Mr. Ruben testifies further that “[b]efore competitors began copying the product, there was no product that incorporated the advantages of the claimed invention on the marketplace.” (Ruben Decl. 2, ¶ 6.)

64. Mr. Ruben testifies further that
at trade shows, I have been directly approached by customers
who have directly stated the combination of the transfer sheet,
the strip and “two-part”/bisected release layers aids in the

application of the invention to furniture and the like.
Customers have also expressed satisfaction regarding the gap
between the strips on the transfer sheet.”

(Ruben Decl. 2, ¶ 8.)

65. According to Mr. Ruben, customers also like the way the product
deters “their pets’ behavior because it causes an unpleasant sticking
sensation when touched.” (Ruben Decl. 2, ¶ 8.)

66. Mr. Ruben testifies that large scale buyers have commented that
products incorporating “the bisected release layer, the combination of the
transfer sheet, the strip and ‘two-part’/bisected release layer and the
adhesives’ ability to cause an unpleasant sticking sensation” sell well.
(Ruben Decl. 2, ¶ 9.)

C. Discussion

As the Appellant, Pemberton bears the procedural burden of showing
harmful error in the Examiner’s rejections. *See, e.g., In re Kahn*, 441 F.3d
977, 985-86 (Fed. Cir. 2006) (“On appeal to the Board, an applicant can
overcome a rejection [under § 103] by showing insufficient evidence of
prima facie obviousness or by rebutting the *prima facie* case with evidence
of secondary indicia of nonobviousness”) (citation and internal quote
omitted). Arguments not timely raised in Pemberton’s principal Brief on
appeal have been waived. 37 C.F.R. § 41.37(c)(1)(vii), 2d sentence (2009).

Pemberton devotes the substance of its arguments to the patentability
of claim 1.

Prima Facie Obviousness

Pemberton objects first that the Examiner failed to establish a prima facie case of obviousness because the rejection is “inarticulate.” More precisely, Pemberton urges that the question of whether the Examiner considers the release layers or the entire articles of Ferraro and Straub to be “equivalents” cannot be resolved. (Br. 10-11.) This argument is without merit.¹³ First, Pemberton has not explained why or how the alleged ambiguity has prevented it from mustering an adequate response. Second, Pemberton has articulated a response to both positions, so it is not clear how Pemberton has been prejudiced by any ambiguity.

On the merits, Pemberton denies that the devices or release layers of Straub and Ferraro are structurally equivalent because the lengths of the release layers are required to be different by Straub (in order to avoid contact with the adhesive during the die cutting process), whereas they are required to be the same by Ferraro (as shown in Figures 5, 6, and 7). (Br. 11.) Pemberton further denies that the release layers are functional equivalents because the release layers are removed differently; by lifting an exposed edge (Straub), versus by bending an embossed corner up and then grasping it (Ferraro). (*Id.*) According to Pemberton, these structural and functional differences also show that there would have been no motivation to combine the references. (Br. 14-15.) Notably, however, Pemberton does not contest the Examiner’s characterizations of Straub regarding release layers.

¹³ To the extent Pemberton felt the Examiner’s action was so inadequate that no response could advance prosecution, a petition for supervisory review would appear to have been appropriate.

Pemberton's arguments are not persuasive of harmful error in the Examiner's determination that it would have been obvious to use release layers as taught by Ferraro or Kriozere with other adhesive strips, such as those taught by Ittershagen or Straub. Indeed, the Examiner found, and Pemberton has not contested, that Ittershagen, Straub, and Ferraro are each concerned with double-sided adhesive articles in which the adhesive article is removed from a first release layer ("transfer sheet," in the language of claim 1), applied to a surface, and then a second release layer is removed from the other adhesive layer. Each reference provides ways to protect the adhesive layers and to handle the adhesive articles during storage and when positioning the articles for use.

Pemberton's attempts to read more into the Examiner's use of the term "equivalent" are not persuasive because Pemberton has failed to point to any credible evidence of record indicating that the articles would have been rendered unsuitable for their ultimate intended uses when modified with different release layers. In particular, the differences in the details of how the second releasing layer is arranged or removed have not been shown to make a significant difference in the articles as disclosed by the references. Pemberton's related arguments that there would have been insufficient motivation to combine the teachings of the references are not persuasive. Pemberton attributes, without credible supporting evidence, an undue lack of imagination in problem-solving to persons having ordinary skill in the art. *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 420-21 (2007) ("A person of ordinary skill is also a person of ordinary creativity, not an automaton.")

Moreover, Pemberton appears to read too much into the appealed claims, and to conflate some of the requirements attributed to the appealed

claims with “requirements” of the references. For example, Pemberton argues that claim 1 requires that the release layers have a length “substantially the same as the length of each of the strips.” According to Pemberton, Straub and Ferraro have length requirements that conflict in this regard. (Br. 9-11.) This argument is not persuasive of harmful error because the Examiner’s rejection does not rely on the direct combination of any two references. Pemberton has not, for example, explained how the length of release layers taught by any of the references would be a critical factor in modifying the double-sided adhesive sheets taught by Ittershagen.

Furthermore, the 461 Specification does not define the term “substantially the same length.” Nor has Pemberton directed our attention to any disclosure in the 461 Specification that would exclude a slight overhang of the release layer relative to the adhesive. Ferraro does not define a term similar to “substantially the same length.” Straub does require an overhang of the tab top liner 14 relative to the transfer adhesive area 12. But Pemberton has not directed our attention to any disclosure in Ferraro that indicates that protective coatings or coverings 9 or 13 cannot or should not overhang the adhesive layers 11 on plastic sheet or film 15. Pemberton’s arguments that the references “teach away” from the combinations of teachings proposed by the Examiner are similarly unsubstantiated. The Federal Circuit has indicated that, to teach away, a reference must state that it “should not” or “cannot” be used in combinations with the other reference. *Para-Ordnance Mfg., Inc. v. SGS Importers Int’l, Inc.*, 73 F.3d 1085, 1090 (Fed. Cir. 1995). Pemberton has not come forward with any credible evidence of such “teachings-away” in any of the references.

Similarly, Pemberton has not come forward with any credible evidence or argument that persons concerned with the arrangement of release layers on double-sided adhesive articles would not look to references such as Kriozere, which is concerned, in part, with the arrangement of release layers on a single-sided adhesive article. The potential advantages of being able to expose an adhesive surface in portions, rather than all at once, are familiar to anyone who has sealed boxes or gift wrappings with tape, or who has applied adhesive-backed items such as labels to a surface. Kriozere provides hard evidence of such considerations.

Pemberton's arguments (Br. 16) that the small sizes of the adhesive articles described by Straub and by Ferraro would dissuade a person having ordinary skill in the art from using bisected release layers are inapposite. First, there are no size limitations in the appealed claims. Moreover, the argument improperly limits the teachings of the references to particular embodiments. Neither Straub nor Ferraro limits their teachings to "small" items.

Pemberton objects further that neither Ferraro (Br. 11) nor Kriozere (Br. 12-13) describes "bisected" release layers. Pemberton maintains that the term "bisected," as used in the claims, means "cut in two equal pieces." (Br. 11.) Pemberton offers an internet dictionary definition of "bisected" as "[t]o cut or divide into two parts, *especially* equal parts." (Br. 12-13; Evidence App. A; emphasis added.) Pemberton also cites, but does not quote, the description of the release layer in the 461 Specification. (Br. 13.) That description reads: "[i]n the embodiment shown [in Figure 2, which is reproduced *supra*, at 6], release layer 27 is longitudinally bisected into two *separate* portions as shown by cut 29." (Spec. 5, ll. 13-14; emphasis added.)

Neither the dictionary definition nor the passage in the Specification supports Pemberton's argument. The dictionary indicates that the general definition of "bisect" is to cut an item into two parts. Although the dictionary also indicates that a common meaning of "bisect" is to cut the item into two equal parts, as a matter of claim interpretation, the more general definition is applied in the absence of a clear intention to the contrary. *In re Hyatt*, 211 F.3d 1367, 1371-72 (Fed. Cir. 2000) ("during examination proceedings, claims are given their broadest reasonable interpretation consistent with the specification.") The Specification indicates that the bisection is into two separate portions, and while it is true that Figure 2 shows that the parts are about the same size, we shall not read limitations from the drawings or the Specification into the claims unless those limitations are proved to be inherent. Here, Pemberton has not directed our attention to any credible evidence showing that a person having ordinary skill in the art would have understood the term "bisect," as used in the claims or in the supporting disclosure, to require that the two pieces be the same size.¹⁴

¹⁴ When asked at oral argument how critical the interpretation of the term "bisected" is to its case for nonobviousness, counsel appeared to concede that the broad reading would render the case for obviousness much closer. We do not agree, in that, on the present record, the precise position of the split appears to be a matter of convenience. As long as neither piece is much larger or much smaller than the other, a person having skill in the art would expect that any proportion of split release layers would make the double-sided adhesive strip easier to handle. This reasonable expectation is an indicia of obviousness.

Pemberton relies on the features of claim 1 discussed *supra* for the patentability of the subject matter covered by dependent claims 2 and 3. (Br. 20-21.) Accordingly, claims 2 and 3 stand or fall with claim 1.

We conclude that Pemberton has not shown harmful error in the Examiner's conclusion that the claimed subject matter would have been *prima facie* obvious in view of the teachings of the references. On the present record, we conclude that claim 1 presents a combination of familiar elements that does no more than yield predictable results, and is therefore likely to have been obvious. *KSR*, 550 U.S. at 415-16. We therefore turn to consider the objective evidence of non-obviousness advanced by Pemberton.

Secondary Considerations

Objective evidence of non-obviousness, including commercial success and industry praise, must be commensurate in scope with the claims which the evidence is offered to support. *Asyst Tech. Inc. v. Emtrak, Inc.*, 544 F.3d 1310, 1316 (Fed. Cir. 2008) (reh'g and reh'g en banc den'd), citing *In re Grasselli*, 713 F.2d 731, 743 (Fed. Cir. 1983). Thus, commercial success, "usually shown by significant sales in a relevant market" is not deemed to be relevant if the success is due to an unclaimed feature of the device, or if the feature that creates the commercial success was known in the prior art. *Ormco Corp. v. Align Tech., Inc.*, 463 F.3d 1299, 1312 (internal quotes and citations omitted). As our reviewing court has held, "the asserted commercial success of the product must be due to the merits of the claimed invention beyond what was readily available in the prior art." *J.T. Eaton & Co. v. Atl. Paste & Glue Co.*, 106 F.3d 1563, 1571 (Fed. Cir. 1997). In any event, all evidence submitted in support of commercial

success, including the level of experience in the market, the degree of market power, evidence of industry acceptance and copying by others, and any affidavits or testimony, must be considered and weighed by the finder of fact. *Pro-Mold & Tool Co. v. Great Lakes Plastics, Inc.*, 75 F.3d 1568, 1574 (Fed. Cir. 1996). That evidence must then be weighed against the evidence favoring obviousness.

The Federal Circuit has observed that “the PTO lacks the means or resources to gather evidence which supports or refutes the applicant’s assertion that the sales constitute commercial success.” *In re Huang*, 100 F.3d 135, 139-140 (Fed. Cir. 1996) (citing *Ex parte Remack*, 15 USPQ2d 1498, 1503 (BPAI 1990).) “Consequently,” the court continued, “the PTO must rely upon the applicant to provide *hard evidence* of commercial success.” *Huang*, 100 F.3d at 139-40 (emphasis added). Sales figures alone are generally inadequate because “[w]ithout further economic evidence . . . it would be improper to infer that the reported sales represent a substantial share of any definable market.”) *Id.*, quoting *Cable Elec. Prods., Inc. v. Genmark, Inc.*, 770 F.2d 1015, 1026-27 (Fed. Cir. 1985).

On the merits,¹⁵ the Declarations of Ms. Pemberton and of Mr. Ruben are not adequately probative of commercial success of the claimed invention. Even if we were to accept the Declarants' representations that the marketed product shown in Exhibit A and described in Exhibit C embodies all the features recited in claim 1, we have not been presented with sufficient credible evidence to find that the marketed product is co-extensive with the claimed subject matter. In particular, we are left to infer from Ms. Pemberton's statement that Fe-Lines, Inc. "only spends a small fraction of its income on advertising" (Pemberton Decl. 3, ¶ 14), that sales are due to the merits of the invention embodied in the claimed features rather than unclaimed features such as particular properties of the adhesive, promotional campaigns, and so forth.

¹⁵ Both the Pemberton and the Ruben Declarations conclude with the statement, "I declare under penalty of perjury that the foregoing is true and correct." (Pemberton Decl. 4; Ruben Decl. 2.) We understand these statements to be, in spirit and intent, in compliance with USPTO regulations governing declarations, 37 C.F.R. §§ 132 and 68, particularly the portion of § 68 that reads:

Such declaration may be used in lieu of the oath otherwise required, *if, and only if*, the declarant is on the same document, warned that willful false statements and the like are punishable by fine or imprisonment, or both (18 U.S.C. 1001) and may jeopardize the validity of the application or any patent issuing thereon. The declarant must set forth in the body of the declaration that all statements made of the declarant's own knowledge are true and that all statements made on information and belief are believed to be true.

37 C.F.R. § 1.68 (2009) (emphasis added); 49 Fed. Reg. 48452 (Dec. 12, 1984).

More critically, the declarational evidence does not place us in a position to assess whether the sales are “significant in a relevant market.” Neither Ms. Pemberton nor Mr. Ruben have provided any hard evidence for their estimate that their sales of \$1 Million represent 70-80% of the market. They do not say how they defined the relevant market goods, i.e., what items are considered to be substitutes or functional equivalents, and why that set is appropriate.¹⁶ Nor do the Declarants indicate what portion of those sales is due to the Sticky Paws for Furniture™ product, and how much is due to the Sticky Paws for Plants™ product represented by Exhibit B, which is not relevant to this appeal. In sum, we have little “hard evidence” regarding the sales of the items beyond the total dollar amount of the sales and the number of units. Although the sales figures and growth in sales appear large, on the present record, a determination that they represent “significant sales in a relevant market” would require undue speculation.

The evidence of industry praise presented by Ms. Pemberton, namely the awards (Exhibits H, I, and J) and the laudatory mention in trade publications (Pemberton Decl. 3, ¶ 13) are noted. We find, however, that the awards are not entitled to significant weight as evidence of unexpected

¹⁶ In this regard, we understand Ms. Pemberton’s testimony that “[t]he only prior art that is directly related to my invention that I am aware of is double sided tape offered by 3-M Company” (Pemberton Decl. 2, ¶ 9) to be directed to prior art relevant to obviousness, not to the products offered for sale for the protection of household goods and furniture from clawing cats. We take official notice that the clawing activities of cats and means of deterring such activities or limiting the consequent damage to household items have long been a concern to cat care-providers. But the record provides no evidence of the size of the market, e.g., how much money has been spent on what articles in commerce in this country for such matters.

results or commercial success of the claimed products because none discuss the entire claimed product. Indeed, with the exception of the ASPCA Consumer Products News Release, the awards do not mention any limitations of the articles recited in claim 1. Put another way, the awards do not show that the claimed product—the packaged double-sided adhesive strips attached on one side to a single release layer and on the other to paired release layers—was meritorious. No evidence regarding the recommendations of the product in award-winning books has been made of record. While it may be reasonable to infer that the reviewers were impressed with the performance of the double-sided adhesive strips in protecting furniture from clawing and clinging cats, there is little to suggest that the totality of what is claimed—i.e., the adhesive strips arranged on and covered by specified release layers—was what merited their attention.

The testimony presented by Mr. Ruben regarding the laudatory remarks made by individual consumers as well as large-scale buyers (Ruben Decl. 2, ¶¶ 8 and 9) is noted. The comments, as reported by Mr. Ruben, relate directly to features of the product that are recited as limitations in the claims. As such, they weigh in favor of commercial success. The quality of the nexus between the sales and the claimed invention, however, is weak. In a similar situation, the Federal Circuit suggested that “an affidavit from the purchaser explaining that the product was purchased due to the claimed features” would provide factual evidence of such a nexus. *Huang*, 100 F.3d at 140. The testimony of Mr. Ruben, a party with an interest in the successful sales of the product, is a poor substitute for testimony from a disinterested purchaser. There are many reasons why an attendee of a trade show might say positive things about an item, and even more reasons why a

representative might hear laudatory remarks. Thus, while we do not impugn the sincerity or truthfulness of Mr. Ruben, we are unable to accord his testimony significant weight regarding the reasons individual purchasers may have been impressed by or bought the products.

The evidence of copying presented in Exhibits E, F, and G is at best equivocal as to the legal issue of non-obviousness.¹⁷ There is no hard evidence that the competitors had access to Pemberton's invention prior to developing and selling their products, or that they copied Pemberton's invention. The similarity of the wording of the competitor's instructions to the instructions provided with the Sticky PawsTM product provided by Pemberton, shown in Exhibit C, might lead to a reasonable inference of substantial copying of the text. But instructions for simple devices that are easy to use are often similar. Moreover, the record does not indicate the scale of copying. Finally, according to the redacted report on the adhesive used in the first and second competitors' products, presented as Exhibit K, the adhesives are different from the one used in Pemberton's product. It is not clear how this report supports a conclusion of copying. Rather, the report seems to suggest that there are a number of readily available equivalent adhesives.

When, as here, the weight of the evidence strongly supports the conclusion that the claimed product would have been *prima facie* obvious, more than inferences of similar items and similar instructions is required to prove copying. In summary, absent more concrete evidence of copying, we

¹⁷ The picture of the first competitor's product shown in Exhibit D is essentially featureless, and therefore is of no probative value. However, reasonably clear illustrations of the product are presented in Exhibit E.

decline to accord significant weight to the evidence offered as proof of copying.

Obviousness is a legal conclusion based on underlying facts. The evidence supporting a conclusion of obviousness must be weighed against evidence supporting a conclusion of non-obviousness. In the present case, the record shows that a similar prior art product—the double-sided pressure-sensitive adhesive tape described by Ittershagen—was known and used for the same purpose of deterring cats from scratching furniture and other household items. The record also shows that the use of release layers to temporarily cover adhesive layers was known, and that various arrangements of the release layer, including longitudinally split release layers, were recognized as being useful. All of these facts support a strong case of *prima facie* obviousness.

In contrast, the objective evidence of non-obviousness is equivocal. We are not insensitive to the efforts Pemberton has put forth to sell a product that consumers find useful, nor to her sometimes frustrating efforts to obtain the exclusionary protection of a patent for her invention. We are constrained by the weakness of the substantive content of the Declarations to conclude that evidence of commercial success in a relevant market is lacking because the relevant market has not been adequately defined. Moreover, we do not have an adequate basis to conclude that the \$1 Million in sales generated in 2005 is attributable to something disclosed in the patent application that was not readily available in the prior art. Nor have we an adequate basis to conclude that the laudatory comments or the alleged copying are strong indications of nonobviousness.

We conclude that the evidence in favor of obviousness outweighs the evidence in favor of nonobviousness. Thus, the conditions for excluding the claimed subject matter from the public have not been met.

D. Order

We AFFIRM the rejection of claims 1-3 under 35 U.S.C. § 103(a) in view of the combined teachings of Straub, Ferraro, Kriozere, and optionally Ittershagen.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

AFFIRMED

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